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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,270	12/07/1999	BRUCE J. KOKKO	2130(FJ-99-1	6225

7590 08/26/2003

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EXAMINER

ALVO, MARC S

ART UNIT	PAPER NUMBER
	1731

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/456,270	KOKKO, BRUCE J.
	Examiner	Art Unit
	Steve Alvo	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 May 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-5, 7-10, 13-15, 17-20, 31-35, and 56-64 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-5, 7-10, 13-15, 17-20, 31-35, and 56-64 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: _____ .

Applicant elected the claims drawn to the process of making an absorbent sheet and elected the species 1-(2-octadecenamidoethyl)-2-heptadecenyl-3-methylimidazolinium methyl sulfate as the quaternary ammonium surfactant and PEG dioleate as the non-ionic surfactant in Paper No. 5, such restriction is made Final. New claims 62-64 are not drawn to the elected species, 1-(2-octadecenamidoethyl)-2-heptadecenyl-3-methylimidazolinium methylsulfate and PEG dioleate, and are withdrawn from consideration.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-10, 13-15, 17-20, 31-35, and 56-64 are rejected under 35 U.S.C. 103(a) as obvious over ADMITTED PRIOR ART (IDS filed 10-15-2001) in view of OSBORN '699 and BACK et al '681.

The ADMITTED PRIOR ART (Formulations A and B) teaches using the same quaternary ammonium surfactant and a very similar cationic surfactant used by Applicant to treat paper pulp with a debonding composition (Formulation A) to make an absorbent sheet. OSBORN '699 also teaches using quaternary ammonium surfactant and a nonionic surfactant to make absorbent sheet materials. OSBORN '699 teaches that the same amount of quaternary ammonium surfactant (column 4, lines 32-37) and nonionic surfactant (column 4, lines 63-66) can be used in the composition, e.g. 0.5 5.0 g/kg bone-dry fiber of each of the surfactants. It

would have been obvious to use the surfactants of the ADMITTED PRIOR art in the proportions taught by OSBORN '699. At best Applicant is optimizing the "debonding", "absorbency" and "softening" of the prior art. There is a reasonable expectation that the debonding of the prior art would yield a sheet material having the desired amount of "debonding", "absorbency" and "softening". *In re O'Farrel*, 7 USPQ2d 1673, 1680-81. In any event, it is well settled that an artisan with ordinary skill would have found it obvious to determine workable or even optimum values for an art recognized, result effective parameter, such as the proper amount of "debonding", "absorbency" and "softening", *In re Boasch*, 205 USPQ 215, 219; *In re Aller*, 105, USPQ 233, 235. OSBORN '699 also teaches (column 4, lines 41-66) the alternativeness of using various alkoxylated esters of a fatty acid as the nonionic surfactant. The use of the elected species, PEG dioleate, would have been obvious from the teachings of OSBORN '699. See OSBORN, III for using alkoxylated and ethoxylated fatty acids and alcohols, including PEG-9 oleate and PEG-4 dilaurate. The specific alkoxylated and ethoxylated fatty acids and alcohols appear to be commercially available. It would have been *prima facie* obvious to substitute one alkoxylated or ethoxylated fatty acid or alcohol surfactant for another. BACK et al teaches that absorbent sheets can be made from recycle paper, e.g. newspapers. It would have been obvious to the artisan to use the recycled wood pulp of BACK et al as the wood pulp of the ADMITTED PRIOR ART. This would have been especially obvious as the debonding composition (Formulation B) is promoted by its manufacturer as being "Best on virgin and mixed virgin/recycled", see IDS page 2, last paragraph. Clearly Formulation B can be used on recycled pulp.

The 11-25-2002 Declaration, of Dr. Bruce J. Kokko, has been considered. However, the Declaration does not compare the elected process to the closest prior art, e.g. formulation A. It would have been *prima facie* obvious to substitute one nonionic surfactant for another. The Declaration states that Formulation A, which is the closest Prior Art (a commercially available debonder composition), uses a PEG dioleate. This is the same PEG-oleate as the elected species. Applicant compares formulae A to formulation P that does not have a PEG-dioleate, but instead uses PEG-400-monooleate. Applicant states that Formulation P is the formulation "of the Application. It is assumed Applicant is comparing the instant invention (Formula P) to the closest Prior Art (formula A). PEG-400-monooleate is not the elected species. The Examiner has not searched such a species. The broad claims read on the elected species, PEG-dioleate, and the 132 Declaration does not overcome the *prima facie* case of obviousness over Formulation A, the **ADMITTED PRIOR ART**.

The May 15, 2003 Declaration of Dr. Bruce J. Kokko does not overcome the rejection as the claims are drawn to a HLB value of "greater than about 10". This term does not define over the HLB value of 9.8 of formulation A.

The argument that Series O has 1/3 less quaternary surfactant than Series A is not convincing, as the amount of quaternary surfactant is not claimed in claim 1.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114.

See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the primary examiner should be directed to Steve Alvo whose telephone number is (703) 308-2048. The Examiner can normally be reached on Monday - Friday from 6:00 AM - 2:30 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **(703) 308-0661**.

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MSA
August 25, 2003



STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731